

AMENDMENTS TO THE DRAWINGS:

At page 2 of the Office Action, the Examiner objected to the drawings. In order to overcome this objection, new FIG. 6 is submitted herewith. Approval of this figure is respectfully requested.

REMARKS

INTRODUCTION

In accordance with the foregoing, the specification has been amended. Claims 2 and 9 have been amended, claim 10 has been cancelled, and no claims have been added. FIG. 6 is hereby added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-9 are pending and under consideration. Reconsideration is respectfully requested.

OBJECTION TO THE DRAWINGS

At page 2 of the Office Action, the drawings were objected to. New FIG. 6 has been submitted herewith. Therefore, the outstanding drawing objection should be resolved.

Reconsideration and withdrawal of the outstanding objection to the drawings is respectfully requested.

REJECTION UNDER 35 U.S.C. §103 OF CLAIMS 1-2 AND 5-9

At page 3 of the Office Action, claims 1-2 and 5-9 were rejected under 35 U.S.C. §103(a) as being unpatentable over "the applicant's admitted prior art" ("AAPA")¹ in view of U.S. Patent No. 6,577,566 issued to Tomita. Claim 9 has been amended to include the subject matter of herein cancelled dependent claim 10. Accordingly, the rejection of claim 9 is discussed in a later section. Regarding the remaining claims, the rejection is traversed for at least the reasons discussed herein. Reconsideration is respectfully requested.

Regarding claims 1 and 8, the rejection is traversed because the proposed combination of AAPA and Tomita fails to teach or suggest:

generating a jump signal in response to a state of the land/groove
signal varying; and

¹ As discussed herein, the Applicants traverse the Examiner's characterization of what the Applicants have admitted as prior art.

moving the optical pickup back by $\frac{1}{2}$ of a track in response to the jump signal

as recited in claim 1, for example.

The Examiner cites paragraph 8, lines 1-5 of the current specification for the above-recited features of claim 1. The Applicants respectfully disagree. The section of the Applicants specification cited by the Examiner recites in its entirety:

However, when an optical pickup of a disc drive playing a DVD-RAM disc with the above-described L/G structure is automatically paused, a number of times (FG) a spindle motor has rotated is counted or track identifications (Ids) are read so as to move the optical pickup back by $\frac{1}{2}$ of a track. However, when data is recorded in either land tracks or groove tracks, it is not useful to move the optical pickup back during inspection of a quality of a radio frequency (RF).

This section does not mention or suggest generating a jump signal in response to a state of a land/groove signal varying, and moving the optical pickup back by $\frac{1}{2}$ of a track in response to the jump signal. Further, the Applicants have found no mention or suggestion in Tomita of these features. Accordingly, the Applicants respectfully submit that the proposed combination of AAPA and Tomita cannot be properly relied upon for teaching or suggesting the generating and moving operations. The Applicants respectfully submit that independent claim 8, although varying in scope, contains similar recitations.

The Applicants respectfully submit that at least because neither AAPA nor Tomita, individually or combined, teach or suggest all of the features of claims 1 and 8, the proposed combination of AAPA and Tomita fails to establish a prima facie case of obviousness. Accordingly, claims 1 and 8 are deemed to be allowable over the art of record. Therefore, withdrawal of the §103 rejection is respectfully requested.

Regarding the rejection of claims 2 and 5-7, these claims depend directly or indirectly on independent claim 1, and are therefore believed to be allowable for at least the reasons noted above.

Additionally, the Applicants respectfully submit that the Office Action fails to provide a valid line of reasoning from the prior art to combine the teachings of AAPA and Tomita. Rather, the Office Action states regarding claim 1, for example:

The two are analogous art because they both deal with the same field of invention of switching from land to groove tracks.

At the time of invention it would have been obvious to one of ordinary skill in the art to provide the method of the applicant's admitted prior art with the tracking and land/groove signals of

Tomita. The rationale is as follows: At the time of invention it would have been obvious to provide the method of the applicant's admitted prior art with the tracking and land/groove signals of Tomita because using the polarity of a tracking error signal will accurately tell if the laser is on a land or a groove.

Office Action, page 4, lines 1-8. The Applicants respectfully submit that this, at best, amounts to an improper hindsight reconstruction of the invention. The Office Action does not assert that a motivation, suggestion, or teaching to combine the teachings of the references exists explicitly in the prior art. Nor does the Office Action assert that a motivation, suggestion or teaching comes from the nature of the problem to be solved. Instead, the Office Action contains a conclusory statement of a generalized advantage and a convenient assumption regarding one of ordinary skill in the art. Conclusory statements of generalized advantages and convenient assumptions are inadequate to support a finding of a motivation in the prior art. Irah H. Donner, *Patent Prosecution: Law Practice, and Procedure* Ch. 8.II.D.19 (4th ed. 2004) (citing *In re Beasley*, Civ. App. 04-1225, slip op. at 6-7, 2004 WL 2793170 (Fed. Cir. Dec. 7, 2004) (unpublished)). Accordingly, withdrawal of the 103 rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. §103 OF CLAIMS 3 AND 4

At page 5 of the Office Action, claims 3 and 4 were rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Tomita further considered with U.S. Patent Publication No. 2002/0054974 by Takahashi et al. ("Takahashi"). At least for the reasons set forth herein, this rejection is traversed and reconsideration is respectfully requested.

The Examiner states that in "regard to claims 3 and 4, the applicant's admitted prior art and Tomita teach all the elements of claims 3 and 4 except" the features of dependent claims 3 and 4. However, claims 3 and 4 depend ultimately on independent claim 1, which as discussed above, recites features not taught or suggested by the proposed combination of AAPA and Tomita. Takahashi is not alleged to make up for this deficiency. Therefore, withdrawal of the §103 rejection is respectfully requested.

Further, the Applicants respectfully submit that the Office Action fails to provide a valid line of reasoning from the prior art to combine the teachings of Takahashi with AAPA and Tomita. Rather, the Office Action states on pages 5 and 6:

The three are analogous art because they all deal with the same field of invention of recording an optical media.

At the time of invention it would have been obvious to one of ordinary skill in the art to provide the method of the applicant's

admitted prior art with the tracking and land/groove signals of Tomita and the separate phase corrections of Takahashi et al. The rationale is as follows: At the time of invention it would have been obvious to provide the method of the applicant's admitted prior art with the tracking and land/groove signals of Tomita and the separate phase corrections of Takahashi et al. because treating the land and grooves separately improves the quality of the signal.

The Applicants respectfully submit that these statements amount to conclusory statements of generalized advantages and convenient assumptions regarding one of ordinary skill in the art. Accordingly, withdrawal of the 103 rejection is respectfully requested.

REJECTION UNDER 35 U.S.C. §103 OF CLAIM 10 (NOW INDEPENDENT CLAIM 9)

At page 6 of the Office Action, claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over AAPA in view of Tomita further considered with U.S. Patent No. 5,793,722 issued to Yamamuro. As noted above, claim 9 has been amended to include the subject matter of herein cancelled dependent claim 10. At least for the reasons set forth herein, this rejection is traversed and reconsideration is respectfully requested.

The rejection is traversed because the proposed combination of AAPA, Tomita and Yamamuro fails to teach or suggest:

wherein the optical pickup is automatically paused in response to the land/groove signal.

The Examiner admits that AAPA and Tomita fail to teach or suggest this feature. Instead, the Examiner states that "Yamamuro teaches stopping a tracking operation while jumping from a land to a groove." The Applicants respectfully note that this is not what is recited by claim 9. Rather, claim 9 recites "wherein the optical pickup is automatically paused in response to the land/groove signal." Accordingly, the Applicants respectfully submit that the proposed combination of AAPA, Tomita and Yamamuro cannot be properly relied upon for teaching or suggesting the above recited feature.

The Applicants respectfully submit that at least because AAPA, Tomita and Yamamuro, individually and combined, fail to teach or suggest all of the features of claim 10, the proposed combination of AAPA, Tomita and Yamamuro fails to establish a prima facie case of obviousness. Accordingly, claim 10 is deemed to be allowable over the art of record. Therefore, withdrawal of the §103 rejection is respectfully requested.

Additionally, the Applicants respectfully submit that the Office Action fails to provide a valid line of reasoning from the prior art to combine the teachings of Yamamuro with AAPA and Tomita. Rather, the Office Action states on page 6:

The three are analogous art because they all deal with the same field of invention of switching from land to groove tracks.

At the time of invention it would have been obvious to one of ordinary skill in the art to provide the method of the applicant's admitted prior art with the tracking and land/groove signals of Tomita and the track switching operation of Yamamuro. The rationale is as follows: At the time of invention it would have been obvious to provide the method of the applicant's admitted prior art with the tracking and land/groove signals of Tomita and the track switching operation of Yamamuro because there would be greater accuracy in switching tracks if the optical pickup was stopped.

The Applicants respectfully submit that these statements amount to conclusory statements of generalized advantages and convenient assumptions regarding one of ordinary skill in the art. Accordingly, withdrawal of the 103 rejection is respectfully requested.

CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

Serial No. 10/724,138

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: Nov. 30, 2006

By: 
Christopher P. Mitchell
Registration No. 54,946

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501